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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK D. BRAXTON

Appeal 2007-3034
Application 09/745,585
Technology Center 2600

Decided: February 8, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and MAHSHID D. SAADAT, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claim 3, which is the only claim remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's claimed invention relates to entertainment program broadcasting which provides an on-demand method of user entertainment allowing the user to select between conventional programming and on-demand programming. Further provided is the background download and storage of entertainment items meeting user selected criteria permitting a user to select from the stored entertainment items as an on-demand service. (Specification 2).

Claim 3 is illustrative of the invention and reads as follows:

3. An on-demand method of entertaining a user using an entertainment device comprising the steps of:

providing a conventional entertainment to the user;

monitoring a remote broadcast of for-demand movie data;

receiving the for-demand movie data;

storing the received for-demand movie data;

providing the operator with a selection of choices corresponding to stored for-demand movie data;

receiving a user input designating an entertainment choice representing one of the choices corresponding to stored for-demand movie data;

using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.

The Examiner relies on the following prior art reference to show unpatentability:

Russo	US 6,025,868	Feb. 15, 2000

Claim 3, the sole claim on appeal, stands rejected under 35 U.S.C. § 102(e) as being anticipated by Russo.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUE

Under 35 U.S.C § 102(e), does Russo have a disclosure which anticipates the invention set forth in claim 3?

PRINCIPLES OF LAW

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

ANALYSIS

With respect to the 35 U.S.C. § 102(e) rejection of appealed claim 3 based on the Russo reference, the Examiner indicates (Ans. 3) how the various limitations are read on the disclosure of Russo. In particular, the Examiner directs attention to the illustration in Figure 2 of Russo as well as the accompanying description at column 8, line 64 through column 10, line 19 of Russo.

Appellant's arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Russo so as to establish a prima facie case of anticipation. Appellant's arguments focus on the contention that, in contrast to the claimed invention, Russo does

not disclose the monitoring, as a background function, of remote broadcasts for on-demand movie data. According to Appellant (Br. 6-8), Russo utilizes downloaded and stored future schedule information to schedule automatic recording of for-demand movies and, accordingly, does not disclose, nor has any need for, the monitoring of broadcast for-demand movie data.

After reviewing the disclosure of Russo in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. Our interpretation of the disclosure of Russo coincides with the Examiner. Initially, we find no persuasive arguments from Appellant that convince us of any error in the Examiner's finding (Answer 3-4) that the scanning of stored for-demand movie data stored in the future record memory 156 satisfies the claimed remote broadcast data monitoring requirement as claimed. In other words, the scanning, i.e., monitoring, of the stored program schedule of for-demand movie data is a monitoring of remote broadcast for-demand movie data as claimed since such remote broadcast is the source of the downloaded and stored for-demand movie data.

We further take note of the Examiner's citation (Ans. 4) of Russo's disclosure (col. 9, ll. 58-61) of the ability to create automatic and unattended recordings of the scheduled movies as indicated in the stored future program schedule memory 156. In our view, such disclosure would lead the skilled artisan to the conclusion that the monitoring of the stored broadcast for-demand movie program data is taking place in the background and is not apparent to the user as claimed. It is well settled that even if a reference fails

to explicitly spell out every detail of a claimed invention, such a reference would anticipate a claim if it discloses the claimed invention "such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*." *In re Graves,* 69 F.3d 1147, 1152 (Fed. Cir. 1995), quoting from *In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)(emphasis in original).

We also make reference to the disclosure at column 10, lines 5-19 of Russo which, in our opinion, further supports the Examiner's stated position. As described in Russo, movie titles may be automatically downloaded dependent on criteria such as user preferences and previously viewed movies. We fail to see how such automatic downloading and storage of for-demand movies could take place without the content monitoring of the remote broadcast of such for-demand movie data.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Russo, the Examiner's 35 U.S.C. § 102(e) rejection of appealed claim 3 is sustained.

CONCLUSION

In summary, we have sustained the Examiner's 35 U.S.C. § 102(e) rejection of claim 3, the only claim on appeal. Therefore, the decision of the Examiner rejecting claim 3 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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